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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,162	02/08/2002	Nobuchika Hirashima	7388/72600	7831

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FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/16/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/049,162	Applicant(s) HIRASHIMA ET AL.	
	Examiner Shian T. Luong	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5</u> . | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

1. The article 34 amendment submitted on 2/8/02 has only claims 1-6. It is not clear whether claims 7-10 are still pending. For the purpose of this Office Action only, claims 7-10 will be examined.

***Claim Rejections - 35 USC § 112***

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 6, the term "said tearing lines" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 in view of S61-108257. JP S57-111822, JP S55-134822 and JP S56-60730 all disclose of a roll-wound plaster with a medicinal part on the plaster. JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 in view of S61-108257, however, does not disclose a cover nor the specific material. S61-108257 discloses a tape-protecting case with left and right covers engaging a core and protecting the side surfaces of adhesive tape. The engaging element is the protrusion shown in Figures 2-3. It would have been

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obvious to form a roll by winding a adhesive strip around the outside of a core but within the cover to prevent soiling and deformation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cover out of ployacrylonitrile resin and the core out of polyethylene terephthalate resin , since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claims 1-5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art on page 1 of the specification in view of Tomaiuolo (US 5,782,786). Admitted Prior Art discloses external patch rolls composed of a dispenser core and a strip-like patch wrapped around the outer perimeter side. The external patches are usually constructed with a support made of nonwoven fabric, an adhesive layer laminated on one side thereof and a covering attached to the adhesive layer in a releasable manner. Admitted Prior Art does not disclose two covers adjacent to the roll and the specific material. Tomiuolo teaches an adhesive bandage on a strip of material. The bandages are separated by perforations or slits. It would have been obvious in view of Tomiuolo to provide covers attached to the spool to surround the edges of the strip to prevent contamination. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cover out of ployacrylonitrile resin and the core out of polyethylene terephthalate resin , since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1, further in view of Official Notice. The modified reference

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does not disclose the width and spacing of the perforation slits. But one of ordinary skill in the art would determine the proper width of the slit and the spacing between the slits through routine experiments. Hence, it would have been obvious to provide a width of 1.0-2.0mm and a slit spacing of 1.0-1.5mm by experimenting different size of cut and location.

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 1, further in view of S61-108257. Admitted Prior Art as modified above does not disclose separate cover engagements. However, S61-108257 discloses a tape-protecting case with left and right covers engaging a core and protecting the side surfaces of adhesive tape. The engaging element is the protrusion shown in Figures 2-3. It would have been obvious to make the covers separate from the spool to allow ease of cleaning and detachment.

### *Conclusion*

8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.

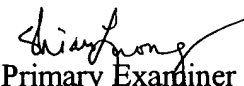
If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

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For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302 and for After Final Amendment the number is (703) 872-9303. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on T-F from 7:00am to 4:00pm EST.

STL  
September 10, 2003

  
Primary Examiner  
Shian Luong  
Art Unit 3728